UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/567,271	02/06/2006	Junbiao Zhang	PU030241	9732

24498 7590 05/06/2010

Robert D. Shedd, Patent Operations
THOMSON Licensing LLC
P.O. Box 5312
Princeton, NJ 08543-5312

EXAMINER	
VU, PHY ANH TRAN	

ART UNIT	PAPER NUMBER
2437	

MAIL DATE	DELIVERY MODE
05/06/2010	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/567,271	ZHANG ET AL.	
	Examiner	Art Unit	
	PHY ANH VU	2437	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *12 March 2010*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-31* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-31* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 3/12/2010 has been entered.

Response to Arguments

Applicant's arguments with respect to claims 1-6, 10-13, 16-20, and 23-27 have been considered but are moot in view of the new ground(s) of rejection.

Examiner Notes

Examiner cites particular columns and line numbers in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that, in preparing responses, the applicant fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 10-28, and 30-31 are rejected under 35 U.S.C. 101 because the claimed inventions directed to non-statutory subject matter.

Claim 10 is rejected under 35 U.S.C. 101 based on Supreme Court precedent and recent Federal Circuit decisions, a 35 U.S.C § 101 process must (1) be tied to a particular machine or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. In re Bilski et al, 88 USPQ 2d 1385 CAFC (2008); Diamond v. Diehr, 450 U.S. 175, 184 (1981); Parker v. Flook, 437 U.S. 584, 588 n.9 (1978); Gottschalk v. Benson, 409 U.S. 63, 70 (1972); Cochrane v. Deener, 94 U.S. 780,787-88 (1876).

Here, applicant's method is not tied to a particular machine and does not perform a transformation. Thus, the claim is non-statutory.

Claims 11-15 and 30 are rejected under 35 U.S.C. 101 as non-statutory for at least the reason stated above. Claims 11-15 are dependent on claim 10; however, they do not add any feature or subject matter that would solve any of the non-statutory deficiencies of claim 10.

Claims 16-28 and 31 are rejected for the same rationale as claims 10-15, and 30 above.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-2, 4-5, 10-13, and 29-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rix et al (US 6,385,317-hereinafter Rix), and further in view of Creighton et al (US 2002/0032665-hereinafter Creighton).

Regarding claim 1, Rix discloses a device, located at a remote site in communication with a network having at least one server and a content requester, comprising:

processor in communication with a memory, said processor operable to execute code for (*Fig. 1, elements 5, 10 and 11; Column 2, lines 16-19*):

receiving a first information item comprising an access code and a content key scrambled using a key known by said device (*Column 2, lines 33-59)* said access code generated by said at least one server in response to a request for a second information item by the content requester (*column 2, lines 22-29, 52-54*);

descrambling said first information using the key known by said device *(column 2, lines 56-59)*;

transmitting said access code to the server hosting said second information item *(Column 2, lines 59-column 3, line 3)*.

receiving said second information item scrambled using said content key after said server hosting the second information item verifies said access code (Column 2, line 62-column 3, line 7).

Rix does not explicitly disclose said access code is transmitted to a different server other than the at least one server.

However, Creighton discloses digital certificate (access code) issued by the certification authority (the at least one server) to the business partner is transmitted to the limited access website of the business owner (different server) for verification before access to sensitive information is granted (*[0012][0046]-[0047]*).

One of ordinary skill in the art at the time the invention was made would have been motivated to incorporate the structure of Creighton into the device of Rix to provide for an effective and efficient system of distributing tasks (*[0007]*) .

(Please also see, MPEP 2144.04(V)(C) Making Separable. In re Dulberg, 289 F.2d 522, 523, 129 USPQ 348, 349 (CCPA 1961) (The claimed structure, a lipstick holder with a removable cap, was fully met by the prior art except that in the prior art the cap is "press fitted" and therefore not manually removable. The court held that "if it were considered desirable for any reason to obtain access to the end of [the prior art's] holder to which the cap is applied, it would be obvious to make the cap removable for that purpose.

Regarding claim 2, Rix also discloses said processor is further operable to execute code for:

Descrambling said second information item using said content key (*Column 2, lines 64-column 3, line 7*)

Regarding claim 4, Creighton also discloses transmitting said access code in unencrypted form, said transmitting being selected from the group consisting of : automatically, at a predetermined time, at a predetermined time offset, responsive to a manual input (*[0012][0035]-[0036]0047]*).

Regarding claim 5, Rix also discloses the device as recited in claim 1, wherein said content key is selected from the group consisting of: a public key, a shared key (*Column 3, lines 4-15*).

Claim 10 is rejected for the same rationale as claim 1 above.

Claim 11 is rejected for the same rationale as claim 3 above.

Claim 12 is rejected for the same rationale as claim 5 above.

Claim 13 is rejected for the same rationale as claim 6 above.

Regarding claim 29, Rix also discloses the transmitting step is performed after a predetermined time from when an initial request for said second information item is sent to said at least one server (*Column 2, lines 52-59*).

Claim 30 is rejected for the same rationale as claim 29 above.

Claims 16-20, 23-27, and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rix and further in view of Taki (US Patent 7,392,393-hereinafter Taki).

Regarding claim 16, Rix discloses a method for transferring secure content over a network comprising the steps of:

receiving a request for content at a first server over a first network from a file requesting device (*Column 2, lines 20-29,52-67*)

generating a first information containing an access code and a content key at said first server in response to said request for content by said file requesting device (*Column 2, lines 52-54*)

transferring said first information item to said designated remote site having said file receiving device (*Column 2, lines 56-59*), wherein said access code and said content key are scrambled using an encryption key (*Column 2, lines 54-56*)

receiving said access code from said designated remote site having said file receiving device (*Column 2, lines 59-62*)

transferring secure content over a network after verification of said access code, wherein said secure content is encrypted using said content key (*Column 2, lines 65-column 3, line 15*)

Rix does not explicitly disclose receiving a request for content at a first server over a first network from a file requesting device, said request including an encryption key known to a designated remote site, and transferring content over a second network.

However, Taki discloses receiving a request for content at a content distribution server over a first network from a mobile information terminal, said request including a public key of the home PC (*Figs. 2 and 3; column 12, lines 23-31*), and transferring content over to the home PC which corresponds to the recited second network (*Figure 3; column 8, lines 51-56*)

One of ordinary skill in the art at the time the invention was made would have been motivated to incorporate the features disclosed by Taki into the device of Rix to allow users using a mobile terminal having small memory issue a request for a content to be downloaded at a different user's device (*column 2, lines 7-26*) .

(Please also see, MPEP 2144.04(V)(C) Making Separable. In re Dulberg, 289 F.2d 522, 523, 129 USPQ 348, 349 (CCPA 1961) (The claimed structure, a lipstick holder with a removable cap, was fully met by the prior art except that in the prior art the cap is "press fitted" and therefore not manually removable. The court held that "if it were considered desirable for any reason to obtain access to the end of [the prior art's] holder to which the cap is applied, it would be obvious to make the cap removable for that purpose.

Regarding claim 17, Taki also discloses wherein said first network and said second network are the same network *(Figure 1).*

Regarding claim 18, Taki also discloses the method as recited in claim 16, wherein a file requesting device is selected from the group consisting of: personal digital

assistant, cellular telephone, notebook computer and personal computer. *(Figures 2 and 3, mobile information terminal)*

Regarding claim 19, Taki also discloses a file receiving device is selected from the group consisting of: personal digital assistant, cellular telephone, notebook computer and personal computer *(Taki Fig. 1, element 120; Col 8, lines 51-63, home PC which corresponds to personal computer).*

Regarding claim 20, Taki also discloses a first network is a wireless network (*Taki Fig. 1, elements 130 & 150, wherein the mobile information terminal is in communication with the content distribution server via wireless connection, thus implies that the network is wireless*)

Regarding claim 23, Rix also discloses transferring over a network said secure content after verification of said access code, wherein said secure content is scrambled using said content key (*Column 2, lines 59-column 3, line 15*).

Regarding claim 24, Rix also discloses the step of transferring said access code and said content key is over said first network (*Fig. 2; Column 2, lines 52-59*)

Regarding claim 25, Rix and Taki disclose the step of transferring said access code and said content key is over a second network (*Rix-Column 2, lines 54-59;* Creighton- *[0012][0035]-[0036]*).

Claim 26 Taki also discloses said second network is a high-speed network (*Fig. 1, wherein home PC communicates with content distribution server*).

Regarding claim 27, Rix and Taki also discloses said second network is a content delivery network *(Rix-column 2, line 64-column 3, line 3; Taki-Figure 3, column 8, lines 51-56).*

Claim 31 is rejected for the same rationale as claims 29 and 30 above.

Claims 3 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rix, Creighton, and further in view of Ohmori (US 2004/0049464-hereinafter Ohmori).

Rix and Creighton do not disclose said first information item includes a use-limit indication.

However, Ohmori discloses a use-limit indication *([0025])*

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teachings of Ohmori into the device of Rix and Creighton to effectively limiting user's use of work stored in storage mediums *([0010])*

Regarding claim 6, Hori also discloses use-limit indication is selected from the group consisting of: number uses, time-period *([0089], wherein time period allowed for reproduction is restricted).*

Claims 7-9, and 14- 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rix ,Creighton, and further in view of WIPO (WO 02/32026 A1, hereinafter Henrick).

Regarding claim 7, Rix and Creighton do not disclose wherein said first information item further includes a content location.

However, Henrick discloses content location *(e.g: Page 8, lines 4-5, wherein the location of the content is transmitted to the PC).*

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Henrick into the system of Taki in view of Hori because it would provide for the user to quickly know the destination of the content.

Regarding claim 8, Henrick also discloses transmitting content location *(e.g: Page 8, lines 4-5, wherein the location of the content is transmitted to the PC, therefore, it's implied that a processor is operable to execute code for transmitting content location).*

Regarding claim 9, Henrick also discloses transmitting content location to PC *(e.g: Page 8, lines 4-5, wherein the location of the content is sent to the PC, which implies that the location of content is already known).*

Claim 14 is rejected for the same rationale as claim 7 above.

Claim 15 is rejected for the same rationale as claim 9 above.

Claims 21 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rix ,Taki, and further in view of WIPO (WO 02/32026 A1, hereinafter Henrick).

Claim 21 is rejected for the same rationale as claim 7 above.

Claim 28 is rejected for the same rationale as claim 9 above.

Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rix, Taki and further in view of Kuriya et al (US 2001/0056404 A1, hereinafter Kuriya).

Regarding claim 22, Rix and Creighton do not disclose the step of transmitting said content to at least one other server in communication with said first server.

However, Kuriya discloses the step of transmitting said content to at least one other server in communication with said server (*Fig. 10, elements S1303 and S1205, wherein content is transmitted from shop server to manager server*)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Kuriya into the system of Rix and Creighton because it would provide for the most effective way of managing content distribution, by cross checking with each other to make sure information received is correct before a request is processed *([0213-0215])*.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to PHY ANH VU whose telephone number is (571)270-7317. The examiner can normally be reached on Mon-Thr 7:30-5:00 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Emmanuel Moise can be reached on 571-272-3865. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/PHY ANH VU/
Examiner, Art Unit 2437

/Emmanuel L. Moise/
Supervisory Patent Examiner, Art Unit 2437